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10/802,038	03/17/2004	Christian Decker	13909-152001 / 2003P00916	3461

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FISH & RICHARDSON, P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
LA, ANH V	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/802,038	DECKER ET AL.	
	Examiner	Art Unit	
	Anh V. La	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-91* is/are pending in the application.

4a) Of the above claim(s) *44-86* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-43,87-91* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 8-17, 20-23, 25, 27-34, 36, 38-43, and 87-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Hull (US 7,129,840).

Regarding claim 1, Hull discloses a document management system comprising a physical-document monitoring device comprising a document coupling device (column 4, lines 6-12, col. 2, lines 35-42), a sensor (RFID tags, 112, 416) coupled to the document coupling device, the sensor operable to sense a state of a document and to generate a signal representative thereof, and a computer (col. 2, line 55) coupled to the sensor, the computer operable to determine the document state based on the signal.

Regarding claim 20 , Hull discloses a method by which a physical-document monitoring device facilitates management of a physical document comprising sensing a state of the physical document (RFID tags, 112, 416), generating a signal representing the documents state, determining the document state based on the signal, and generating a wireless signal representing the document state (fig. 1-7).

Regarding claim 33 , Hull discloses an article comprising a machine-readable medium storing instructions operable to cause a physical-document monitoring device comprising one or more machines to perform operations comprising determining whether a state of a document has been sensed (RFID tags, 112, 416), determining the document state, and generating a wireless message representing the document state (fig. 1-7).

Regarding claims 2, 22, Hull discloses the document coupling device being adapted to bind the document (col. 4, line 5-12, col. 6, lines 45-55).

Regarding claims 3, 23, 34, Hull discloses the document state comprising the number of document pages (col. 9, lines 1-25).

Regarding claim 4, Hull discloses the sensor component comprising a radio frequency identification (RFID) tag and associated interrogation device (column 1, line 59- col. 2, line 3) and the document coupling device incorporating the tag (col. 4, lines 6-20). Therefore, it is clearly seen that the document coupling device is part of the sensor and facilitates sensing the document state.

Regarding claim 8, Hull discloses a wireless communication device sending data from and receiving data for the computer (col. 3, lines 40-46).

Regarding claim 9, Hull discloses the sent data comprising the determined document state (figures 1-7).

Regarding claims 10, 28, 39, Hull discloses state data for a non-physical version of document (col. 4, lines 20-38).

Regarding claims 11, 27, 38, Hull discloses document meta-data (col. 4, lines 20-50, col. 8, lines 45-67).

Regarding claim 12, Hull discloses a text string (col. 4, lines 20-50, col. 8, lines 45-67).

Regarding claims 13, 25, 36, Hull discloses a document location (col. 5, lines 10-55, col. 8, lines 10-22).

Regarding claims 14, 29, 40, Hull discloses an allowable document state and storing the allowable document state (col. 4, lines 30-38).

Regarding claim 15, Hull discloses a rule that expresses the allowable document state (col. 4, lines 30-38).

Regarding claims 16, 30, 41, Hull discloses determining whether the allowable document state has been violated (col. 8, lines 10-32).

Regarding claims 17, 31, 42, Hull discloses a displaying device providing a visual indication of physical document status (col. 8, lines 10-38).

Regarding claim 21 , Hull discloses coupling a physical-document monitoring device to the document (fig. 1-7).

Regarding claims 32, 43, Hull discloses a user input device (col. 7, lines 5-32) and a wireless message (col. 7, lines 5-32).

Regarding claims 87-89, Hull discloses a paper-base document (col. 4, lines 5-12).

Regarding claim 90 , Hull discloses the document coupling device being adapted to couple the monitoring device to a physical document (col. 2, lines 1-3, col. 4, lines 6-12).

Regarding claim 91 , Hull discloses a paper clip (col. 4, lines 6-12).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull in view of Murray (US 4,170,346).

Regarding claim 5, Hull discloses all the claimed subject matters as set forth above in the rejection of claim 1, but still does not disclose the sensor sensing the pages based on capacitance (claim 5). Murray teaches the use of the sensor sensing the pages based on capacitance (col. 3, lines 30-46). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the sensor sensing the pages based on capacitance to the system of Hull as taught by Murray for the purpose of effectively sensing the state of the document.

5. Claims 6-7, 18, 19, 26, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull in view of Back (US 6,262,662).

Regarding claims 6-7, 26, 37, Hull discloses all the claimed subject matters as set forth above in the rejection of claim 1, but still does not disclose an environmental condition of the document and the environmental condition comprising illumination. Back teaches the use of an environmental condition of a document and the environmental condition comprising illumination (abstract, col. 6, lines 25-46). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include an environmental condition of the document and the environmental condition comprising illumination to the system of Hull as taught by Back for the purpose of effectively sensing the state of the document.

Regarding claim 18, Hull discloses all the claimed subject matters as set forth above in the rejection of claim 1, and further discloses a user input device (col. 7, lines 5-32), but still does not disclose the user input device coupled to the computer. Back teaches the use of a user input device coupled to a computer (figure 1). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the user input device coupled to the computer to the system of Hull as taught by Back for the purpose of effectively controlling the operation of the system.

Regarding claim 19, Hull discloses a wireless message (col. 7, lines 5-32).

6. Claims 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull in view of Wittmer (US 5,892,444).

Regarding claims 24 and 35, Hull discloses all the claimed subject matters as set forth above in the rejection of claim 23, but still does not disclose sensing an electrical

value affected by a dielectric. Wittmer teaches the use of sensing an electrical value affected by a dielectric (col. 2, lines 30-67). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include sensing an electrical value affected by a dielectric to the system of Hull as taught by Wittmer for the purpose of effectively sensing the state of the document.

Answers to Remarks

7. Applicant's arguments filed December 06, 2007 have been fully considered.

Regarding claim 1, in response to applicant's argument that nowhere does Hull teach a sensor coupled to a document coupling device and operable to sense a state of a document and to generate a signal representative thereof, this argument is not persuasive. Applicant's attention is directed to column 1, line 59- col. 2, line 3 and column 4, lines 6-12, where Hull clearly discloses a sensor (RFID tags, 112, 416) coupled to the document coupling device (col. 1, line 59- col. 2, line 3, col. 4, lines 6-12), and the sensor operable to sense a state of a document and to generate a signal 114 representative thereof.

In response to applicant's argument on page 17, lines 10-15, of the remarks filed December 06, 2007 that the Examiner is confusing the sensors 112 with the RFID tags 416 and applicant further states that Hull does not disclose that the RFID tags 416 are operable to sense a state of a document and to generate a signal representative thereof, these arguments are not persuasive. Applicant's attention is directed to column

1, line 55- col. 2, line 3, where Hull clearly discloses sensors for sensing a state of a document and collecting sensing information and the sensor component comprising a radio frequency identification (RFID) tag and associated interrogation device with details supported in columns 3-5.

Therefore, Hull clearly teaches all limitations of claim 1.

Regarding claim 3, in response to applicant's argument that Hull fails to teach the document state comprising the number of document pages, this argument is not persuasive. Applicant's attention is directed to column 1, line 59- col. 2, line 3 and column 8, line 10- col. 9, line 25, where Hull clearly discloses the document state comprising the number of document pages.

Regarding claim 4, in response to applicant's argument that Hull fails to teach that a sensor includes a document coupling device, this argument is not persuasive. Hull discloses the sensor component comprising a radio frequency identification (RFID) tag and associated interrogation device in column 1, line 59- col. 2, line 3 and the document coupling device incorporating the tag in column 4, lines 6-20. Therefore, it is clearly seen that the document coupling device is part of the sensor and facilitates sensing the document state.

Regarding claim 8, in response to applicant's argument that Hull fails to teach a wireless communication device coupled to the computer and the wireless communication device operable to send data from and receive data for the computer, this argument is not persuasive. Applicant's attention is directed to column 3, lines 1-46,

column 1, line 59- col. 2, line 3, column 2, lines 50-67, and figure 1, where Hull clearly discloses a wireless communication device coupled to the computer and the wireless communication device operable to send data from and receive data for the computer.

Regarding claim 10, in response to applicant's argument that Hull fails to teach the received comprising state data for a non-physical version of document, this argument is not persuasive. Hull clearly discloses the received comprising state data for a non-physical version of document in column 4, lines 20-38, column 3, lines 1-46, column 1, line 59- col. 2, line 3, column 2, lines 50-67, and figure 1.

Regarding claim 17, in response to applicant's argument that Hull fails to teach the monitoring device comprising a displaying device operable to provide a visual indication of physical document status, this argument is not persuasive. It is clearly seen that a display device must be provided in order to display the visual information that is recorded by the recording device 708 in column 8, lines 10-38.

Applicant's arguments with respect to claim 18 have been considered but are moot in view of the new ground(s) of rejection.

Therefore, Hull clearly teaches all limitations of claims 2-4, 8-17, 20-23, 25, 27-34, 36, 38-43, and 87-91.

Regarding claim 5, in response to applicant's argument that Murray fails to teach the sensor sensing the number of pages based on capacitance, this argument is not persuasive. Murray clearly teaches the sensor sensing the number of pages based on capacitance in column 3, lines 30-46.

Regarding claim 6, in response to applicant's argument that Back fails to teach the document state comprising an environmental condition of a document, this argument is not persuasive. Back clearly teaches the document state comprising an environmental condition of a document in abstract and column 6, lines 25-46.

Therefore, combination of Hull and Murray teaches all limitations of claim 5; combination of Hull and Back teaches all limitations of claims 6-7, 18, 19, 26, and 37; and combination of Hull and Wittmer teaches all limitations of claims 24 and 35.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh V. La whose telephone number is (571) 272-2970. The examiner can normally be reached on Mon-Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anh V La/
Primary Examiner, Art Unit 2612

Anh V La
Primary Examiner
Art Unit 2612

AI
February 29, 2008